



PATENT

THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Randolph A. Stern and Michael N. Byles
Serial No.: 09/558,329
Filed: April 25, 2000
Art Unit: 1771
Examiner: Cheryl Juska
Title: Stitch Bonded Fabric and Fluid-Retaining Fabric
Made Therewith
Atty Docket: STAN-09RE

Auto 13

Assistant Commissioner for Patents
Washington, D.C. 20231

TRANSMITTAL OF APPEAL BRIEF (PATENT APPLICATION-37 CFR 1.192)

1. Transmitted herewith in triplicate is the APPEAL BRIEF in this application with respect to the Notice of Appeal filed on September 25, 2001.

2. STATUS OF APPLICANT

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VERIFIED STATEMENT:

☐ attached
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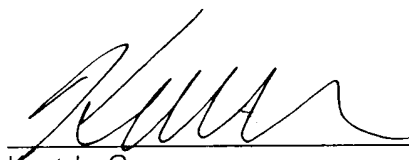
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Reg. No. 29,799

Nov. 26, 2001

Date



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte Stern et al.
Appeal No. _____

#15
2-12-01
CJN

Applicant: Randolph A. Stern and Michael N. Byles
Serial No.: 09/558,329
Confirmation No.: 9722
Filed: April 25, 2000
Examiner: Cheryl Juska
Group Art Unit: 1771
Title: Stitch Bonded Fabric and Fluid-Retaining Fabric Made Therewith

Cincinnati, OH 45202

November 26, 2001

Assistant Commissioner for Patents
Washington, D.C. 20231

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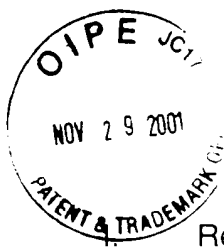
BRIEF ON APPEAL

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Keith R. Haupt
Reg. No. 37,630

Nov. 26, 2001
Date

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Assistant Commissioner for Patents
Washington, D.C. 20231

BRIEF ON APPEAL

I. Real Party in Interest

The real party in interest is Standard Textile Co., Inc., of Cincinnati, Ohio, which is the assignee of the present invention.

II. Related Appeals and Interferences

There are no related appeals or interferences known to Appellants, the Appellants' legal representative, or to the assignee which will directly affect or be directly affected by or have a bearing on the decision of the Board in the present appeal.

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III. Status of the Claims

Claims 1-87 are currently pending and are subject to this appeal. Claims 1-29 were originally issued in Appellants' U.S. Patent No. 5,902,757 ("the '757 patent"). Appellants subsequently filed the present re-issue application in which claims 1-29 are maintained and broader claims 30-87 have been added.

IV. Status of Amendments

One core issue in this proceeding is the construction of the claim term "yarn face". Appellants submit that the specification clearly defines the term as requiring that it be a fabric face of yarns that are spaced closely enough to be "effectively continuous" such that a felt web on which the face is formed is not generally exposed at the face. Appellants were of the view, and understood Examiner to agree, that if the term "yarn face" was properly construed to be "effectively continuous", the claims would distinguish over the art cited by Examiner. Appellants previously offered to amend the claims according to indications in the Final Office Action that such a feature would distinguish the prior art (see Request to Withdraw Finality of Office Action dated July 19, 2001), so as to make explicit what Appellants submit is meant by the claim term "yarn face". In an unexpected and sudden turnabout, Examiner refused to withdraw the finality of the Office Action to allow such an Amendment and argued that the representations previously made were not going to be honored. Indeed, in the comments attached to the Advisory Action mailed August 14, 2001, it is clear that the art relied upon by Examiner does not show a yarn face which is effectively continuous

(which is what Appellants contend is the proper construction of the claim term in any event), yet Examiner indicated she would not enter an After Final Amendment to make explicit what Appellants believe is implicit in the term "yarn face" and which the Examiner acknowledges in the Final Office Action is a patentable distinction and would result in allowability of claims over the art. Therefore, there are no outstanding or un-entered amendments and the appendix of the claims attached to this brief reflects the claims as filed in the application without amendment. On the other hand, Appellants submit such an amendment is unnecessary, given proper construction of the term "yarn face". They do, however, remain willing to make explicit what is believed to be required of the claim term based on the specification.

V. Summary of the Invention

The invention is an improved fluid-retaining fabric such as may be substituted for the facing fabric and felt of the prior incontinent pads and which reduces the costs of manufacture thereof.

Such products are typically employed in hospitals to retain fluids expelled from the body while also protecting bed linens and the like. Typical prior art incontinent pads have a knitted or woven facing fabric layer, such as cotton (e.g., Birdseye) to which is quilted a felt layer. In fact, a vast majority of all prior art products of this type include a separate facing fabric and a separate felt web or felt layer quilted to the cotton facing fabric. The function of the facing fabric is as the name implies, to confront or face the user and provide a comfortable surface against the user's skin. The combined

facing/felt layers absorb and retain bodily fluids. As detailed in the specification, a facing fabric is "a soft comfortable layer against the patient's skin." (Col. 1, line 16.)

The present invention is provided by stitch bonding in a single process a felt web (typically of one or two layers) with stitch bonding yarns. The stitch bonding yarns define top and/or bottom "yarn faces" of the fabric, with the top yarn face presenting a patient comfort surface, and the bottom yarn face providing a surface such as for adhesive connection to a barrier layer without interfering with either the structural rigidity or absorbency provided by the felt web. As such, the top yarn face is the "facing fabric" because it provides all of the benefits and functions of facing fabrics in prior art products. Importantly however, it is comprised of the stitch bonding yarns and is thus formed in the process of stitch-bonding the yarns to the felt web. That is to be contrasted with prior techniques of separately knitting or weaving a facing fabric, and then quilting it to the felt web, a costly and labor intensive procedure. With the present invention, the stitch-bonding creates, in a less labor intensive manner, the effect of one web that has both a facing fabric and the felt web.

The stitch-bonded fabric of this invention may be utilized as a fluid-retaining fabric and may be incorporated into an incontinent pad such as by the attachment of a barrier layer over the bottom yarn face. By virtue of this invention, an improved facing fabric is provided that incorporates the advantageous features of a felt layer without the added cost of separate manufacture of the facing fabric and the felt, and without the still-further added cost of the quilting process.

In the preferred embodiment, the felt web has hydrophobic and hydrophilic properties, in particular, to simulate the facing fabric behavior of one of the

assignee's prior facing fabrics, known as Comply. One layer or aspect of the felt web is adjacent the yarn face fabric formed at the top, while another layer or aspect of the felt is adjacent the yarn face formed at the bottom. There is nothing, however, in the disclosure that suggests that the hydrophobic and/or hydrophilic properties of the felt are critical, or that requires the invention to be focused on the entire thickness of the felt and both the top and bottom yarn faces. Rather, Appellants are entitled to claims directed, for example, to the upper half of the combined felt and stitch-bonding yarns and yarn face, to the lower half of the combined felt and stitch-bonding yarns and yarn face, and even to the broad concept of stitch-bonded fabric with a felt web and stitch-bonded yarns to form "yarn faces".

To that end, the invention of claims 1-29 (the original claims of the '757 patent) is directed to a stitch-bonded facing fabric, an incontinent pad and/or a fluid retaining product in which the felt web has hydrophilic and hydrophobic properties; however the felt being hydrophobic and hydrophilic is not critical or essential to the invention. Rather, what is essential is that yarns are stitch bonded to a felt web in such a manner as to create at least one yarn face such that the felt is not readily visible through that yarn face. That broader concept is the subject of claims 30-87 added in this reissue proceeding.

VI. Issues¹

1. Whether claims 30-87 comply with 35 U.S.C. § 112, first paragraph, even though these claims do not recite a product having hydrophilic and hydrophobic components.

2. Whether a fabric, incontinent pad or other article according to claims 1-87 having at least one yarn face according to applicant's specification and claims is patentably novel and non-obvious over the prior art cited in the Final Office Action which lacks such a yarn face.

3. Whether a fabric, incontinent pad or other article according to claims 1-29, having hydrophobic or hydrophilic felt components and stitch-bonding is patentably novel and non-obvious over the prior art cited in the Final Office Action.

VII. Grouping of Claims

1. With respect to the Section 112 rejection, claims 30-57 stand or fall together, and claims 58-87 stand or fall together.

2. With respect to the prior art rejections, original claims 1-29 stand or fall together with respect to the hydrophobic/hydrophilic felt aspect. With respect to claims 30-87, Examiner made four anticipation rejections and nine obviousness rejections. Each rejection is applied to certain claims as set forth in the Final Official

In the Final Office Action, Examiner for the first time raised a minor objection to the Reissue Declaration. That issue will be addressed upon return of the case to Examiner after this appeal, and is not believed to be necessary to address here.

Action. With respect to each such ground of rejection, for purpose of this Appeal, those of claims 30-87 identified under the respective rejection stand or fall together.

VIII. Argument

A. Section 112, First Paragraph, Rejection

Claims 30-87 were rejected under 35 U.S.C. § 112, first paragraph, as being allegedly based upon a disclosure which is not enabling. Claims 30-87 are all of the claims which Appellants seek to add to U.S. Patent No. 5,902,757 ("the '757 patent") in this reissue application.

The enablement rejection states that: "The dual layer of a hydrophobic/hydrophilic felt web which is critical or essential to the practice of the invention, but not included in the claims is not enabled by the disclosure. . . . The specification, while being enabling for a web comprising a hydrophobic component and a hydrophilic component, does not reasonably provide enablement for a web not limited to including both phobic and philic components, as is recited in claims 30-87." (Final Office Action dated April 26, 2001, ¶ 4, pg. 3.)

The proper test of enablement is whether one reasonably skilled in the art could make or use the invention from the specification's disclosure with information known in the art and without undue experimentation. Spectra-Physics, Inc. v. Coherent, Inc., 3 U.S.P.Q. 2d, 1737, 1743 (Fed. Cir. 1987), citing Hybritech, Inc. v. Monoclonal Antibodies, Inc., 231 U.S.P.Q. 81, 94 (Fed. Cir. 1986), cert. denied, 107 S. Ct. 1606 (1987); U.S. v. Teletronics, Inc., 8 U.S.P.Q. 2d 1217, 1223 (Fed. Cir. 1988) citing

Hybritech, Inc., 231 U.S.P.Q. at 94. Appellants respectfully assert that since at least one embodiment of a felt web or felt layer is disclosed in the '757 patent specification, that the inventions as recited in claims 30-87 could easily be practiced by those skilled in the art without any experimentation, and most assuredly without undue experimentation. See SRI International v. Matsushita Electric Corp., 227 U.S.P.Q. 577, 586 (Fed. Cir. 1985) (the law does not require an applicant to describe in his specification every conceivable embodiment of the invention).

Frankly, Examiner's position is simply not logical. One of ordinary skill in the art given a disclosure of either two different layers of felt stitch-bonded together, or one ply with two different aspects with stitch-bonding, would readily understand and be able to make the claimed invention of claims 30-87, irrespective of the properties of the felt. Any other position is so far-fetched as to be incredible.

Furthermore, the present invention is directed to stitch bonded fabric and fluid retaining fabric which are used in incontinent pads. This art is not a chemical related art in which the results of experiments are not predictable. The invention is most related to mechanical arts in which the results of experiments are highly predictable. As such, where the results are predictable, broad claims, such as claims 30-87, can be enabled by the disclosure of a single embodiment of the invention. Spectra-Physics, 3 U.S.P.Q. 2d at 1743.

Further, a claim is not invalid for lack of enablement simply because it reads not only on the disclosed embodiment of the invention, but also on other embodiments which may or may not be disclosed in the specification. See Gould v.

Mossinghoff, 219 U.S.P.Q. 393, 396 (D.C. Cir. 1983) aff'd, 3 U.S.P.Q. 2d 1302 (Fed. Cir. 1987).

Thus, Appellants respectfully assert that claims 30-87 are compliant with the enablement requirement of § 112, first paragraph, in that they claim a felt web or layer of felt material and such an embodiment was specifically disclosed in the '757 patent specification. The enablement requirement does not require that the patent disclose every embodiment of the claim but the enablement requirement does state that a broad claim can be enabled by the disclosure of a single embodiment. See Cross v. Iizuka, 224 U.S.P.Q. 739, 748 (Fed. Cir. 1985); Gould v. Mossinghoff, 229 U.S.P.Q. 21, 14 (D.D.C. 1985).

The Board has also acknowledged that claims which are broader than the specific embodiments of the invention disclosed in the specification are enabling and that in mechanical cases and other predictable arts, broad claims may cover more than the specific embodiment disclosed in the specification. Ex Parte Alan J. Knobbe et al., Appeal No. 92-1191, page 4 (PTO Brd. Pat. App. & Int., 1992) citing In Re Vickers, 61 U.S.P.Q. 122 (CCPA 1944) and In Re Newton, 163 U.S.P.Q. 34 (CCPA 1969).

Claims 30-57 each recite a felt web having an upper surface and a lower surface and claims 58-87 each recite a first layer of felt which is either hydrophobic or hydrophilic and having an outer surface. Appellants submit that there can be no dispute that these claims as pending read on the disclosure in the '757 patent specification. However, the § 112 rejection being appealed alleges that the preferred properties of the felt (i.e., hydrophilic and hydrophobic) are critical to the invention and, as such, must also be claimed in order to be enabling. The rejection cites In Re

Mayhew, 527 F.2d 1229, 188 U.S.P.Q. 356 (CCPA 1976) for support. Nevertheless, the claims herein are enabled by the disclosure in the '757 patent and Mayhew not only fails to support the rejection, but establishes the enablement of claims 30-87.

In Mayhew, the claims were directed to a process for producing zinc alloy. There was no dispute that if the process did not include a cooling step, the claimed invention was inoperative. The CCPA had no problem, therefore, affirming the rejection of claims lacking any mention of the cooling step as not being enabled. That was not the end of the Mayhew case, however.

In addition to rejecting of claims lacking the cooling step entirely, the Examiner had also rejected claims which recited the cooling step, but omitted the temperature or function of the cooling step. The CCPA reversed the rejection of those claims holding that the claims are sufficiently enabled without requiring recitation of the properties set forth in the preferred embodiments. Thus, the CCPA in Mayhew held that the critical elements of a functional invention must be present in the claims to be enabling, whereas lack of specific properties of those elements is not fatal to the claims. That is precisely the situation here. The pending claims do recite the critical elements, i.e., stitch bonding yarns and felt web, which are necessary ingredients for a stitch bonded fabric according to the invention. Mayhew does not stand for the proposition that the properties of the felt (e.g, hydrophobic and hydrophilic) must be recited in the claims, for a product made with a felt lacking those properties would still be a functional stitch-bonded fabric.

The properties of the felt being hydrophobic and hydrophilic are not critical or essential to the invention. Rather, what is essential is that yarns are stitch bonded to

felt in such a manner as to create at least one yarn face such that the felt is not readily visible through the yarn face. More will be said about this feature when the prior art rejections are addressed below.

For purposes of the § 112, paragraph 1, rejection, Appellants submit that the focus in the rejection is too narrow and properties which are not essential to a functional fabric or pad made with such fabric are not required in § 112, ¶1. For example, in the Mayhew case, the claim held by the CCPA to be nonenabling was inoperative because a critical step or element (the cooling step) of that invention was not recited in those claims. The other claims which recited a cooling step generally and without the specific temperature/function were held to be enabled.

The same reasoning is directly applicable here. Claims 30-87 recite a felt web without specific properties/function (hydrophilic/hydrophobic) and are enabled. The undeniable fact is that one of ordinary skill in the art of incontinent pads and similar products would readily utilize any number of felt web materials which are well known to practice the invention of claims 30-87, including but not limited to layers of hydrophobic/hydrophilic materials as disclosed in the '757 specification.

The rejection repeatedly refers to the hydrophobic/hydrophilic features of the felt web as being "critical" or "essential" to the practice of the invention and, therefore, since they are not in claims 30-87, the claims are not enabled by the disclosure.² There is no basis for Examiner's position as the specification nowhere says or implies that such properties are critical or essential (indeed, Examiner's position

² Appellants also submit that, as to claims 58-87 which specifically recite a hydrophobic or hydrophilic felt web, the rejections are also factually insupportable.

would make broadening reissues, a statutory right, a virtual impossibility). Moreover, Appellants must point out that according to controlling Federal Circuit and CCPA case law, the critical or essential element analysis is not the proper test for enablement. As previously discussed hereinabove, the proper test for enablement does not focus on a so-called "omitted element test," but rather enablement is established if one reasonably skilled in the art could make and use the invention based upon the disclosure with information known in the art and without undue experimentation. Durel Corp. v. Osram Sylvania, Inc., 59 U.S.P.Q.2d 1238, 1244 (Fed. Cir. 2001) citing Genentech, Inc. v. Novo Nordisk, A.S., 108 F.3d 1361, 1365, 42 U.S.P.Q.2d 1001, 1004 (Fed. Cir. 1997).

The enablement requirement is met if the description in the '757 patent enables one of ordinary skill in the art any mode of making and using a stitch bonded fabric, incontinent pad or the like. The Johns Hopkins University v. Cellpro, Inc., 152 F.3d 1342, 1361, 47 U.S.P.Q.2d 1705, 1719 (Fed. Cir. 1998). To the extent that the rejection is directed toward a written description requirement, the "omitted element test," is not applicable. Reiffen v. Microsoft Corp., 54 U.S.P.Q.2d 1915, 1918 (Fed. Cir. 2000) (Newmann, J., concurring) (The "omitted element test" is an incorrect statement of the law of written description.") See also, Aro Mfg. Co. v. Convertible Top Replacement, Co., 365 U.S. 336, 345, 128 U.S.P.Q. 354 (1961) (There is "no legally recognizable or protected 'essential' element . . . in a combination patent."). It is well established that the claims need not include every component that is described in the specification and the decision in Gentry Gallery, Inc. v. Berkline Corp., 134 F.3d 1473,

45 U.S.P.Q.2d 1498 (Fed. Cir. 1998) does not hold otherwise. Reiffen 54, U.S.P.Q.2d at 1919, citing Aro Mfg. Co.

Thus, while the product which is described in specific embodiments in the '757 patent is an incontinent pad, stitch bonded fabric or fluid-retaining fabric in which the felt web or felt layer is comprised of a specific combination of hydrophobic and hydrophilic layers, Appellants submit that the invention is not so limited. In that regard, claims 30-87 are broader than the hydrophilic/hydrophobic felt materials recited in claims 1-29. Nevertheless, Appellants respectfully assert that the '757 patent specification is fully enabling with respect to claims 30-87 because one of ordinary skill in the art would readily be able to identify a vast array of felt webs or felt layers without undue experimentation that could be utilized in the invention of claims 30-87.

For all these reasons, Appellants respectfully assert that the § 112, first paragraph, rejection of claims 30-87 is improper and request that it be reversed.

B. Prior Art Rejections

1. Background

All of the claims in this reissue application have been rejected based upon one or more of U.S. Patent No. 4,026,129 issued to Sternlieb, U.S. Patent No. 4,181,514 issued to Lefkowitz, U.S. Patent No. 4,675,226 issued to Ott, U.S. Patent No. 5,356,402 issued to Gillies, U.S. Patent No. 4,128,686 issued to Kyle and European Patent No. 261,904 issued to Taylor. Appellants earnestly and respectfully assert that

each of these prior art rejections is wrong and that claims 1-87 are patentably novel and non-obvious.

2. "Yarn Face"

While Appellants submit that each stated rejection in the Final Office Action is in error for a number of reasons, there is one common theme underlying all of the rejections, and which disposes of the rejections. That common theme is the term "yarn face" in each claim.

Each of the claims specifically recite a plurality of stitch bonding yarns which extend through the felt web. The stitch bonding yarns are identified by reference number 18 in the '757 patent and include yarn segments 18' and 18" which extend over or across the upper surface 20 of the web and the lower surface 22 of the web, respectively. This arrangement is particularly shown in Figs. 2 and 5 of the '757 patent. The yarn segments contribute to form a top yarn face 24 and/or a bottom yarn face 26 of the finished fabric which is described in the specification (taken from the '757 patent which is here being sought for reissue) as follows:

It will be appreciated that yarn segments 18' and 18" do not become embedded into the web 12 below surfaces 20 or 22 thereof, but rather extend across the surfaces 20 and 22, and are of sufficient density that yarn segments 18' cooperate to define a top yarn face 24 of fabric 10 above web upper surface 20, and yarn segments 18" cooperate to define a bottom yarn face 26 of fabric 10 below web lower surface 22. Faces 24 and 26 are effectively continuous such that web 12 is not exposed thereat, although small gaps or interstices (as at 28) between adjacent yarn segments 18' or 18" may allow viewing of felt surface 20 or 22 upon close inspection. It will be noted that Figs. 3 and 4 are greatly exaggerated to show interstices 28 in faces 24 and 26. (Col. 2, lines 52-65, emphasis added).

In other words, the resulting product according to this invention includes an upper and/or a lower yarn face. The yarn face is defined as having very closely spaced or densely packed yarn segments of the stitch bonding yarns so as to be effectively continuous such that the felt web is not generally exposed. The benefit of the yarn faces is that the fabric for the incontinent pad has a comfortable surface (i.e., facing fabric) for the patient at the top yarn face and/or the bottom yarn face provides a surface, which may be used, for example, for adhesive connection to a barrier layer without interfering with either the structural rigidity or absorbency provided by the felt web. Appellants respectfully assert that the yarn faces recited in each of the rejected claims is a feature of the fabric or other product according to this invention that is not presently shown, disclosed, or otherwise suggested in the cited art.

Each of the rejections and primary references relied upon will now be individually addressed.

(1) Sternlieb U.S. Patent No. 4,026,129

Sternlieb is directed to a dimensionally stable fabric especially useful for bed sheets, or for the uppers of foot gear such as sneakers, athletic shoes, etc. (Col. 1, Ins. 31-33.) The fabric, as particularly shown in the cross-sectional view of Fig. 7, includes a web 1 with a scrim layer 9 applied to one surface thereof. The two layers 1, 9 are stitch-bonded together by knitting yarns 11, 13.

The Sternlieb patent clearly discloses and teaches in Fig. 7 that portions or ribs of the felt web 31 are exposed and project beyond the upper surface of the stitch bonding yarn segments 11 and 13. Therefore, the upper surface of the fabric in Sternlieb clearly does not provide a "yarn face" as claimed in the present application.

The Examiner has acknowledged this fact by withdrawing a prior anticipatory rejection of claims 30-36 and 51-56 because those claims recite both the top and the bottom yarn faces. Thus, even Examiner understands that "yarn face" as used in the present claims has the meaning Appellants ascribe to it in the specification. Yet, the rejection is maintained as to claims 65 and 67-69 which only require one yarn face.

To support the rejection, Examiner alleges that the lower surface of the fabric of Fig. 7 in Sternlieb presents such a yarn face. However, such an allegation is directly contrary to the teaching of Sternlieb. The patent describes the scrim 9 as presenting an "exposed abrasion resistant surface 26 of the scrim." (Col. 3, Ins. 1-2, emphasis added.) Accordingly, the scrim layer 9 is "exposed" on the lower surface of the fabric as shown in Fig. 7. This is directly contrary to Appellants' claimed invention in which the surface of the scrim, felt web or other material is not exposed because the stitch bonding yarns define a "yarn face", i.e., yarns that are close enough to be effectively continuous and thereby cover a particular surface of the felt web as recited in the claims.

Moreover, a side-by-side comparison of Fig. 7 in the Sternlieb patent with Figs. 2, 5, 7 and 8 of the present application presents a clear distinction. The stitch-bonding yarns in the present case provide an uninterrupted, substantially continuous face; whereas the stitches 11, 13 in Fig. 7 of Sternlieb are spaced significantly from one another thereby providing a substantial amount of exposed scrim sheet and felt web. As such, it is abundantly clear that Sternlieb fails to teach, disclose or otherwise suggest any yarn face as recited in Appellants' claims.³

³ Appellants also wish to point out that contrary to the characterization in the final Office Action, Appellants have never admitted that Sternlieb '129 shows only

(2) **Lefkowitz U.S. Patent No. 4,181,514**

The Lefkowitz patent shows a fibrous bat 2 with a number of stitch yarns 3, 4 significantly spaced from one another as shown particularly in Figs. 3 and 7 of that reference.⁴ Lefkowitz is directed to a filter material. The stitch yarns 3, 4 "comprise metallic monofilament or multifilament yarns or glass multifilament yarns. Such yarns may be used alone or in combination with other non-metallic yarn materials." (Col. 3, lns. 1-4.) Since Lefkowitz is directed to a filter, inherently, a fluid or other medium must pass through the fibrous bat and stitch yarns. Since the stitch yarns are metal, the material being filtered must escape the fibrous bat 2. If the stitch yarns produced a "yarn face" as claimed in Appellants' invention, then the filtered material would not be able to escape the allegedly effectively continuous face. Therefore, the stitch yarns in Lefkowitz can not produce a "yarn face". This fact, in addition to the disclosure of the Lefkowitz patent, renders the anticipatory and obviousness related rejections based on Lefkowitz erroneous.

In the Final Office Action, the Examiner acknowledges that Lefkowitz fails to teach, disclose or otherwise suggest a "yarn face" comprised of stitch-bonded yarns. The Examiner's position with respect to the Lefkowitz patent is apparently that Appellants' yarn face is not claimed as effectively continuous although it is explicitly

one face of stitch yarns. Appellants previously asserted correctly that the upper surface of Sternlieb fails to present a yarn face without previously addressing the lower face nor admitting that the lower face does present a yarn face as alleged in ¶ 30 of the final Office Action.

⁴ The identified figures in Sternlieb '129 and Lefkowitz are considered to accurately portray those respective inventions in contrast to Figs. 3 and 4 of the present case which are "greatly exaggerated" as expressly stated in the specification.

described as such in the specification. Appellants respectfully assert that the term "yarn face" must be defined according to the above quoted text from the specification thus overcoming the rejections based on Lefkowitz.

(3) Ott U.S. Patent No. 4,675,226

The Ott patent is directed to a stitch-bonded composite wiper having excellent strength and absorbency performance and other advantageous features for a variety of industrial, institutional and health care wiping uses. The Ott patent discloses that the preferred stitch used in that product is a length of 3 mm and is spaced in the cross web direction at 14 stitched lines per inch or 14 gauge. (Col. 3, lines 31-34). The stitch density of the wiper disclosed in Ott is very low and is not consistent with a yarn face according to Appellants' claimed invention. The low density of stitches necessarily creates large open gaps rather than an effectively continuous face as in the yarn face.

The Final Office Action does not dispute such an interpretation of the Ott patent but merely reiterates that the effectively continuous feature inherent in the term "yarn face" as used in Appellants' claims is not expressly recited. Once again, Appellants submit that when properly construed, the term yarn face must be considered to be effectively continuous such that the rejected claims distinguish over the cited references.

(4) Gillies U.S. Patent No. 5,356,402

The Gillies patent discloses a polyester thread having a thickness of approximately 150 denier in which the stitch bonding rows are spaced apart to give approximately 2 to 10 rows per inch and most preferably 5 rows per inch such that each

row contains approximately 6 to 20 stitches and most preferably 12 stitches per inch. (Col. 5, lines 25-36). The result of such a low density in both Ott and Gillies is necessarily to create large open gaps rather than an effectively continuous face.

Once again, the Examiner does not dispute that Gillies fails to teach, disclose or otherwise suggest an effectively continuous yarn face. Rather, Examiner again takes the position that the term "yarn face" in the claims cannot be construed to be "effectively continuous" without expressly adding the words to the claims. Appellants assert that such a meaning is inherent in the term "yarn face" such that the rejections based upon Gilles, Ott and Lefkowitz are in error.

(5) Section 103 Rejections

The Section 103 rejections in the final Office Action combine the primary references of Sternlieb, Lefkowitz, Ott and Gillies with each other or other identified secondary prior art. However, nowhere in the Section 103 rejections does the Examiner assert or allege that any of these references teach, disclose or otherwise suggest a "yarn face" as that term is used in the Appellants claims. Therefore, Appellants distinguishing comments set out above with respect to the Sternlieb, Lefkowitz, Ott and Gillies references apply equally to the Section 103 rejections, and the rejections are in error for the same reasons.

In summary, the prior art documents cited in the rejections of claims 1-87 fail to disclose, teach or otherwise suggest a "yarn face" at the top and/or bottom surfaces as in Appellants' claimed invention. The teaching of these prior art patents would lead one of ordinary skill in the art directly away from Appellants' claimed invention in which the stitch bonding yarn segments contribute to define top and/or

bottom yarn faces that are effectively continuous such that the web is not exposed. Moreover, one of ordinary skill in the art would readily be able to optimize the stitch density relative to the selected stitch thickness or denier for a particular application to achieve the yarn faces as described in the rejected claims.

For all these reasons, Appellants respectfully assert that claims 1-87 are neither anticipated by nor rendered obvious in view of the cited references.

3. Additional Issues

In addition to the above, various of the claims are patentable over the art for further reasons as well. Take, for example, original patent claims 1-29. Those claims were all allowed in the original '757 patent over the very same art now being applied by Examiner in this reissue proceeding.

In the original patent, that Examiner indicated as reasons for allowance that the Gillies patent was the closest art, but that it was patentable to use "felt materials for the two layers." (Reasons for Allowance sent with the Notice of Allowability mailed September 15, 1998). Yet, in the reissue, this Examiner (a different Examiner than originally issued the patent) rejected the original claims (1-29) primarily over Gillies and Ott, or Kyle and Gillies, for example, directly contrary to the position of the original Examiner. And Examiner takes this contrary position by ignoring the very teachings of the references upon which she relies.

This Examiner admits that Gillies "separately" stitched a hydrophobic web and a hydrophillic web. From that, Examiner somehow arrives at the claimed invention which stitch bonds at one time, and not separately, the hydrophobic and hydrophillic

aspects. The flimsy notion of motivation to eliminate a step is hardly a persuasive basis to ignore a step necessary for the product of the Gillies patent.

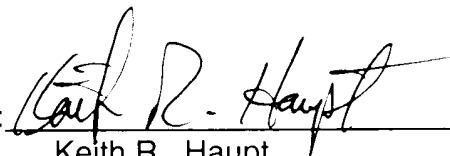
Similarly, Examiner refers to Kyle's separate felt layers which are conventionally quilted together, to suggest they could be stitch-bonded together. Examiner overlooks that, while Appellants' invention produces a product with its own "yarn face", the Kyles product requires an "upper sheet 25" or "protective sheet 41", in order to provide a comfortable facing fabric for the use of yarn face. Appellants' invention eliminates the need for such separate sheets and is thus not obvious over a reference that requires them.

IX. Conclusion

For the reasons stated, Appellants respectfully urge the Board to reverse the rejections of claims 1-87.

Respectfully submitted,

WOOD, HERRON & EVANS, L.L.P.

By: 
Keith R. Haupt
Reg. No. 37,630

2700 Carew Tower
Cincinnati, OH 45202
(513) 241-2324

APPENDIX OF CLAIMS

1. A stitch bonded facing fabric comprising:
 - a first layer of hydrophobic felt;
 - a second layer of hydrophilic felt being adjacent to the first layer so as to define a felt web having an upper surface defined by an upper side of the first layer and a lower surface defined by a lower side of the second layer; and
 - a plurality of stitch bonding yarns repeatedly extending through the felt web with yarn segments extending across both the upper and lower surfaces of the felt web such that the yarn segments extending across the felt web upper surface cooperate to form a top yarn face above the felt web upper surface and the yarn segments extending across the felt web lower surface cooperate to form a bottom yarn face below the felt web lower surface.
2. The stitch bonded fabric of claim 1 further comprising a scrim layer interposed between one of the surfaces of the felt web and the yarn segments extending thereacross.
3. The facing fabric of claim 1 wherein the yarn segments extending across the felt web upper surface form underlaps.

4. The facing fabric of claim 3 wherein the yarn segments extending across the felt web lower surface form overlaps.
5. The facing fabric of claim 1 wherein the yarn segments extending across the felt web lower surface form overlaps.
6. The facing fabric of claim 1 wherein the yarns are stitched in a flat stitch construction across the felt web upper surface.
7. The facing fabric of claim 1 wherein the yarns are stitched in a loop knit construction across the felt web upper surface to define a plurality of yarn loops in the top yarn face.
8. The facing fabric of claim 1 wherein the yarns are hydrophobic.
9. The facing fabric of claim 1 wherein the yarns are hydrophilic.
10. The facing fabric of claim 1 wherein the yarns are continuous filaments.
11. The facing fabric of claim 1 wherein the yarns are spun yarn.

12. A stitch bonded facing fabric comprising:

a felt web having a hydrophobic upper aspect extending from an upper surface of the web and a hydrophilic lower aspect extending from a lower surface of the web;
and

a plurality of stitch bonding yarns repeatedly extending through the felt web with yarn segments extending across both the upper and lower surfaces of the felt web such that the yarn segments extending across the felt web upper surface cooperate to form a top yarn face above the felt web upper surface and the yarn segments extending across the felt web lower surface cooperate to form a bottom yarn face below the felt web lower surface.

13. The stitch bonded fabric of claim 12 further comprising a scrim layer interposed between one of the surfaces of the felt web and the yarn segments extending thereacross.

14. The facing fabric of claim 12 wherein the yarn segments extending across the felt web upper surface form underlaps.

15. The facing fabric of claim 14 wherein the yarn segments extending across the felt web lower surface form overlaps.

16. The facing fabric of claim 12 wherein the yarn segments extending across the felt web lower surface form overlaps.

17. The facing fabric of claim 12 wherein the yarns are stitched in a flat stitch construction across the felt web upper surface.
18. The facing fabric of claim 12 wherein the yarns are stitched in a loop knit construction across the felt web upper surface to define a plurality of yarn loops in the fabric top.
19. The facing fabric of claim 12 wherein the yarns are hydrophobic.
20. The facing fabric of claim 12 wherein the yarns are hydrophilic.
21. The facing fabric of claim 12 wherein the yarns are continuous filaments.
22. The facing fabric of claim 12 wherein the yarns are spun yarn.

23. A fluid-retaining fabric comprising:

a stitch bonded facing fabric having a first layer of hydrophobic felt, a second layer of hydrophilic felt being adjacent to the first layer so as to define a felt web having an upper surface defined by an upper side of the first layer and a lower surface defined by a lower side of the second layer, and a plurality of stitch bonding yarns repeatedly extending through the felt web with yarn segments extending across both the upper and lower surfaces of the felt web such that the yarn segments extending across the felt web upper surface cooperate to form a top yarn face above the felt web upper surface and the yarn segments extending across the felt web lower surface cooperate to form a bottom yarn face below the felt web lower surface; and

a barrier layer attached to the bottom yarn face.

24. The fluid-retaining fabric of claim 23 further comprising adhesive attaching the barrier layer to the bottom yarn face.

25. The fluid-retaining fabric of claim 23 wherein the first and second felt layers are needle punched into a single felt web.

26. The fluid-retaining fabric of claim 23 wherein the barrier layer includes a fluid barrier ply and a fabric ply.

27. The fluid-retaining fabric of claim 26 wherein the barrier ply is attached to the bottom yarn face.

28. The fluid-retaining fabric of claim 23 wherein the barrier layer includes a fluid barrier ply.

29. The fluid-retaining fabric of claim 23 further comprising edge stitching attaching the barrier layer to the bottom yarn face.

30. A stitch bonded facing fabric comprising:

a felt web having an upper surface and a lower surface; and

a plurality of stitch bonding yarns repeatedly extending through the felt web with yarn segments extending across both the upper and lower surfaces of the felt web such that the yarn segments extending across the felt web upper surface cooperate to form a top yarn face above the felt web upper surface and the yarn segments extending across the felt web lower surface cooperate to form a bottom yarn face below the felt web lower surface.

31. The stitch bonded facing fabric of claim 30 further comprising a scrim layer interposed between one of the surfaces of the felt web and the yarn segments extending thereacross.

32. The stitch bonded facing fabric of claim 30 wherein the yarn segments extending across the felt web upper surface form underlaps.

33. The stitch bonded facing fabric of claim 32 wherein the yarn segments extending across the felt web lower surface form overlaps.

34. The stitch bonded facing fabric of claim 30 wherein the yarn segments extending across the felt web lower surface form overlaps.

35. The stitch bonded facing fabric of claim 30 wherein the yarns are stitched in a flat stitch construction across the felt web upper surface.

36. The stitch bonded facing fabric of claim 30 wherein the yarns are stitched in a loop knit construction across the felt web upper surface to define a plurality of yarn loops in the fabric top.

37. The stitch bonded facing fabric of claim 30, the felt web including first and second felt layers being adjacent to one another to define the felt web, the upper surface of the web being defined by an upper side of the first felt layer, the lower surface of the web being defined by a lower side of the second felt layer, the stitch bonded yarns extending through both felt layers.

38. The stitch bonded facing fabric of claim 30 wherein the yarns are hydrophilic.

39. An incontinent pad comprising:

a stitch bonded facing fabric having a felt web having an upper surface and a lower surface and a plurality of stitch bonding yarns repeatedly extending through the felt web with yarn segments extending across both the upper and lower surfaces of the felt web such that the yarn segments extending across the felt web upper surface cooperate to form a top yarn face above the felt web upper surface and the yarn segments extending across the felt web lower surface cooperate to form a bottom yarn face below the felt web lower surface; and

a barrier layer joined to the facing fabric so as to confront the bottom yarn face of the facing fabric.

40. The incontinent pad of claim 39 further comprising adhesive attaching the barrier layer to the bottom yarn face.

41. The incontinent pad of claim 39 further comprising edge stitching attaching the barrier layer to the bottom yarn face.

42. The incontinent pad of claim 39 wherein the barrier layer includes a fluid barrier ply and a fabric ply.

43. The incontinent pad of claim 39, the felt web of the stitch bonded facing fabric including first and second felt layers being adjacent to one another to define the felt web, the upper surface of the web being defined by an upper side of the first felt layer, the lower surface of the web being defined by a lower side of the second felt layer, the stitch bonded yarns extending through both felt layers.

44. The incontinent pad stitch of claim 39 further comprising a scrim layer in the stitch bonded facing fabric and being interposed between one of the surfaces of the felt web and the yarn segments extending thereacross.

45. The incontinent pad of claim 44, the scrim layer being interposed between the felt web lower surface and the yarn segments extending thereacross.

46. The incontinent pad of claim 39 wherein the yarn segments extending across the felt web upper surface of the stitch bonded facing fabric form underlaps.

47. The incontinent pad of claim 39 wherein the yarn segments extending across the felt web lower surface of the stitch bonded facing fabric form overlaps.

48. The incontinent pad of claim 39 wherein the yarns of the stitch bonded facing fabric are stitched in a flat stitch construction across the felt web upper surface.

49. The incontinent pad of claim 39 wherein the yarns of the stitch bonded facing fabric are stitched in a loop knit construction across the felt web upper surface to define a plurality of yarn loops in the fabric top.

50. The incontinent pad of claim 39 wherein the yarns of the stitch bonded facing fabric are hydrophobic.

51. A fluid retaining fabric comprising:

a felt web having an upper surface and a lower surface, the felt being adapted to retain fluid therein; and

a plurality of stitch bonding yarns repeatedly extending through the felt web with yarn segments extending across both the upper and lower surfaces of the felt web such that the yarn segments extending across the felt web upper surface cooperate to form a top yarn face above the felt web upper surface and the yarn segments extending across the felt web lower surface cooperate to form a bottom yarn face below the felt web lower surface, the stitch bonding yarns being hydrophobic whereby to assist in wicking fluid into the felt web.

52. The fluid retaining fabric of claim 51 further comprising a scrim layer interposed between one of the surfaces of the felt web and the yarn segments extending thereacross.

53. The fluid retaining fabric of claim 51 wherein the yarn segments extending across the felt web upper surface form underlaps.
54. The fluid retaining fabric of claim 51 wherein the yarn segments extending across the felt web lower surface form overlaps.
55. The fluid retaining fabric of claim 51 wherein the yarns are stitched in a flat stitch construction across the felt web upper surface.
56. The fluid retaining fabric of claim 51 wherein the yarns are stitched in a loop knit construction across the felt web upper surface to define a plurality of yarn loops in the fabric top.
57. The fluid retaining fabric of claim 51 wherein the yarns are continuous filaments.
58. A stitch bonded facing fabric comprising:
a first layer of felt having hydrophobic properties and further having an outer surface; and
a plurality of stitch bonding yarns repeatedly extending through the first layer of felt with yarn segments extending across the outer surface of the layer of felt, such that the yarn segments extending across the felt layer outer surface cooperate to form a yarn face above the felt layer outer surface.

59. The stitch bonded facing fabric of claim 58 further comprising a second layer of felt adjacent the first layer and having the stitch bonding yarns repeatedly extending therethrough.

60. The stitch bonded facing fabric of claim 58 further comprising a scrim layer interposed between the felt layer outer surface and the yarn segments extending thereacross.

61. The stitch bonded facing fabric of claim 58 wherein the yarn segments extending across the felt web outer surface form underlaps.

62. The stitch bonded facing fabric of claim 58 wherein the yarns are stitched in a flat stitch construction across the felt web outer surface.

63. The stitch bonded facing fabric of claim 58 wherein the yarns are stitched in a loop knit construction across the felt web outer surface to define a plurality of yarn loops.

64. The stitch bonded facing fabric of claim 58 wherein the yarns are hydrophobic.

65. A stitch bonded facing fabric comprising:

a first layer of felt having hydrophilic properties and further having an outer surface; and

a plurality of stitch bonding yarns repeatedly extending through the first layer of felt with yarn segments extending across the outer surface of the layer of felt, such that the yarn segments extending across the felt layer outer surface cooperate to form a yarn face above the felt layer outer surface.

66. The stitch bonded facing fabric of claim 65 further comprising a second layer of felt adjacent the first layer and having the stitch bonding yarns repeatedly extending therethrough.

67. The stitch bonded facing fabric of claim 65 further comprising a scrim layer interposed between the felt layer outer surface and the yarn segments extending thereacross.

68. The stitch bonded facing fabric of claim 65 wherein the yarn segments extending across the felt web outer surface form overlaps.

69. The stitch bonded facing fabric of claim 65 wherein the yarns are hydrophobic.

70. An incontinent pad comprising:

a facing fabric including a first layer of felt having hydrophobic properties and further having an outer surface, and a plurality of stitch bonding yarns repeatedly extending through the first layer of felt with yarn segments extending across the outer surface of the layer of felt, such that the yarn segments extending across the felt layer outer surface cooperate to form a yarn face above the felt layer outer surface; and
a barrier layer joined to the facing fabric.

71. The incontinent pad of claim 70, the facing fabric further including a second layer of felt adjacent the first layer and having the stitch bonding yarns repeatedly extending therethrough.

72. The incontinent pad of claim 70 further comprising adhesive attaching the barrier layer to the facing fabric.

73. The fluid-retaining fabric of claim 70 further comprising edge stitching attaching the barrier layer to the facing fabric.

74. The incontinent pad of claim 70 wherein the barrier layer includes a fluid barrier ply and a fabric ply.

75. The incontinent pad stitch of claim 70 further comprising a scrim layer in the facing fabric and being interposed between the felt web outer layer and the yarn segments extending thereacross.

76. The incontinent pad of claim 70 wherein the yarn segments extending across the felt web outer surface of the facing fabric form underlaps.

77. The incontinent pad of claim 70 wherein the yarns of the facing fabric are stitched in a flat stitch construction across the felt web outer surface.

78. The incontinent pad of claim 70 wherein the yarns of the facing fabric are stitched in a loop knit construction across the felt web outer surface to define a plurality of yarn loops.

79. The incontinent pad of claim 70 wherein the yarns of the facing fabric are hydrophobic.

80. An incontinent pad comprising:

a facing fabric including a first layer of felt having hydrophilic properties and further having an outer surface, and a plurality of stitch bonding yarns repeatedly extending through the first layer of felt with yarn segments extending across the outer surface of the layer of felt, such that the yarn segments extending across the felt layer outer surface cooperate to form a yarn face above the felt layer outer surface; and
a barrier layer joined to the facing fabric.

81. The incontinent pad of claim 80, the facing fabric further including a second layer of felt adjacent the first layer and having the stitch bonding yarns repeatedly extending therethrough.

82. The incontinent pad of claim 80 further comprising adhesive attaching the barrier layer to the facing fabric.

83. The fluid-retaining fabric of claim 80 further comprising edge stitching attaching the barrier layer to the facing fabric.

84. The incontinent pad of claim 80 wherein the barrier layer includes a fluid barrier ply and a fabric ply.

85. The incontinent pad stitch of claim 80 further comprising a scrim layer in the facing fabric and being interposed between the felt web outer layer and the yarn segments extending thereacross.

86. The incontinent pad of claim 80 wherein the yarn segments extending across the felt web outer surface of the facing fabric form overlaps.

87. The incontinent pad of claim 80 wherein the yarns of the facing fabric are hydrophobic.